

## **Remarks**

### **The Rejection of Claims 1-4 Under 35 U.S.C. § 102(e)**

Claims 1-4 was rejected under 35 U.S.C. § 102(e) as being anticipated by United States Patent No. 6,958,858 (*Engelhardt et al.*). Applicant respectfully traverses this rejection and request reconsideration for the following reasons.

Applicant respectfully asserts that Examiner has acknowledged the deficiency of *Engelhardt et al.* regarding a displaceable deflection unit. (Official Action dated December 27, 2005, Page 5, second paragraph, “Engelhardt et al. fail to explicitly teach a displaceable deflection unit.”; and, Page 5, fourth paragraph, “The modified Engelhardt et al. fail to disclose a displaceable deflection unit.”). Moreover, Applicant courteously submits that amended Claim 1 sets forth a limitation not contained in the teachings of *Engelhardt et al.*, i.e., an axially displaceable deflection unit. *Engelhardt et al.* teach “a beam deflection device 17 that contains a gimbal-mounted scanning mirror 19 [ ] that guides illuminating light beam 11 through scanning optical system 21, tube optical system 23, and objective 25 over or through specimen 27.” (Col. 4, lines 62-66). A gimbal-mounted mirror is a mirror mounted to a device that permits the mirror **to incline freely in any direction** or suspends the mirror so that it will remain level when its support is tipped. (<http://www.m-w.com/dictionary/gimbal>, accessed March 7, 2006, emphasis added). Thus, a gimbal-mount permits tilting of a mirror, however a gimbal-mount does not permit axial displacement. Contrarily, Applicant’s “deflection unit 22 [ ] can be displaced in the direction of a double arrow 26 so as thereby to adapt the optical path lengths of the light of first and second laser 4 and 6.” (Para. [0016]). To adapt the optical path lengths, Applicant’s deflection unit 22 is axially displaced in the direction of double arrow 26. Thus, beam deflection unit 17 taught by *Engelhardt et al.*, having gimbal-mounted mirror 19, is not identical to, or the equivalent of Applicant’s axially displaceable deflection unit 22. Thus, in view of the amendment to Claim 1, *Engelhardt et al.* do not anticipate Claim 1 and all claims dependant therefrom.

Furthermore, *Engelhardt et al.* do not disclose, teach, or suggest using an axially displaceable deflection unit. Hence, Applicant's Claim 1 and all claims dependant therefrom are also non-obvious in view of *Engelhardt et al.*.

In view of the foregoing remarks, reconsideration and withdrawal of the rejections of Claims 1-4 as being anticipated by *Engelhardt et al.* are courteously requested.

The Rejection of Claims 5-15 Under 35 U.S.C. § 103(a)

Claims 5-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Engelhardt et al.* in view of United States Patent No. 6,356,088 (*Simon et al. I*) and United States Patent No. 6,466,040 (*Simon et al. II*). Applicant respectfully traverses this rejection and requests reconsideration for the reasons set forth above and the following reasons.

This ground of rejection cannot stand because *Engelhardt et al.*, and the captioned subject invention are **commonly owned**. *Engelhardt et al.* and the instant application are both assigned to Leica Microsystems Heidelberg GmbH, Mannheim, Germany, and thus are **commonly owned**.

Under the present circumstances the rule that should apply is cited as: ¶ 7.21.02 *Rejection, 35 U.S.C. 103(a), Common Assignee or at Least One Common Inventor*, appearing on Page 700-65 of the MPEP, cited below:

¶ 7.21.02 *Rejection, 35 U.S.C. 103(a), Common Assignee or at Least One Common Inventor*

“Claim [1] rejected under 35 U.S.C. 103(a) as being obvious over [2].

The applied reference has a common [3] with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention “by another”; (2) a showing of a date of invention for the claimed subject matter of the

application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). *This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2). [4]*” MPEP § 706.02(m) (emphasis added).

#### **Statement of Common Ownership**

**The captioned Application (Application Serial No. 10/604,636, filed August 6, 2003) and the reference, United States Patent No. 6,958,858 were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same organization.**

Effective November 29, 1999, subject matter which was prior art under 35 U.S.C. 103 via 35 U.S.C. 102(e) is **now disqualified as prior art** against the claimed invention because the subject matter of the *Engelhardt et al.* patent and the claimed invention were, at the time the invention was made, owned by the same person, namely Leica Microsystems Heidelberg GmbH, Mannheim, Germany.

Accordingly, the basis for the rejection of the claims for reasons of obviousness that includes the citation of *Engelhardt et al.* cannot stand because this citation has been effectively removed as a reference.

Assuming *arguendo* that *Engelhardt et al.* could be used to support a rejection under 35 U.S.C. § 103, which it can not, the rejection fails for the following reasons. Regarding Claims 5-7, *Simon et al. I* and *Simon et al. II* do not teach the element missing from *Engelhardt et al.*, i.e., an axially displaceable deflection unit. Regarding Claims 8-15, in like fashion, *Simon et al. I* and *Simon et al. II* do not teach the element missing from *Engelhardt et al.*, i.e., a displaceable deflection unit for setting a path length difference between the light of the first and the second

laser. *Simon et al. I* teach displaceable optics 38, *i.e.*, lenses used to adjust and/or change the beam focus within the specimen (Col. 5, lines 10-12), while *Simon et al. II* teach two-dimensional deflecting unit 6 (Col. 3, lines 45-46) identical to the two-dimensional deflecting unit of *Engelhardt et al.*, *i.e.*, gimbal-mounted mirror 19. The two-dimensional deflecting units taught by *Engelhardt et al.*, *Simon et al. I* and *Simon et al. II* are not axially displaceable deflecting units, or displaceable deflection units for setting a path length difference between the light of the first and the second laser. Therefore, the three references fail to teach all the elements of Applicant's claimed invention.

In order to establish a *prima facie* case of obviousness, the references alone or in combination must teach all the elements of applicant's claimed invention. Thus, as independent Claim 1 contains an element that is not disclosed in the cited references, *i.e.*, an axially displaceable deflection unit, it follows that Claim 1 is patentable over *Engelhardt et al.* in view of *Simon et al. I* and *Simon et al. II*. Dependent Claims 5-7 contain all of the limitations of independent Claim 1, due to their dependency therefrom. Therefore, since Claim 1 is non-obvious in view of *Engelhardt et al.*, and further in view of *Simon et al. I* and *Simon et al. II*, due to the missing element, it necessarily follows that Claims 5-7 are also non-obvious in view of *Engelhardt et al.*, and further in view of *Simon et al. I* and *Simon et al. II*, due to their dependency from Claim 1. In like fashion, as independent Claim 8 contains an element that is not disclosed in the cited references, *i.e.*, a displaceable deflection unit for setting a path length difference between the light of the first and the second laser, it follows that Claim 8 is also patentable over *Engelhardt et al.* in view of *Simon et al. I* and *Simon et al. II*. Dependent Claims 9-15 contain all of the limitations of independent Claim 8, due to their dependency therefrom. Thus, as Claim 8 is non-obvious in view of *Engelhardt et al.*, and further in view of *Simon et al. I* and *Simon et al. II*, due to the missing element, it necessarily follows that Claims 9-15 are also non-obvious in view of *Engelhardt et al.*, and further in view of *Simon et al. I* and *Simon et al. II*, due to their dependency from Claim 8. Accordingly, withdrawal of the rejections of Claims 5-15 under 35 U.S.C. § 103(a) is appropriate and respectfully requested.

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**Conclusion**

For all the reasons outlined above, Applicant respectfully submits that the claims are patentable over the cited references and in condition for allowance, which action is courteously requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Robert C. Atkinson', with a long horizontal line extending to the right.

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